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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------------|---------------------|------------------|
| 09/846,456 | 05/02/2001 | Marie-Francoise Rosier-Montus | 3806.0505 | 1457 |

5487 7590 12/29/2005

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EXAMINER

SULLIVAN, DANIEL M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1636

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|---------------------------------------|---|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/846,456 | Applicant(s) ROSIER-MONTUS ET AL. | |
| | Examiner Daniel M. Sullivan | Art Unit 1636 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 17 November 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

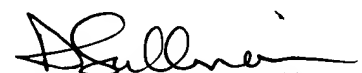
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-3 and 5-38.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


DANIEL M. SULLIVAN
PATENT EXAMINER

Continuation of 3. NOTE: Claims 2, 3 and 5, which were previously limited to comprising 500 or more consecutive nucleotides of SEQ ID NO: 1 by virtue of their dependence from claim 1 have been amended such that they are now independent of the limitations of claim 1 and, therefore, no longer required to comprise 500 or more consecutive nucleotides of SEQ ID NO: 1. The amendment expands the scope of the claims such that a new search and consideration of the claims for compliance under 35 U.S.C. §112 is necessitated. In the remarks, Applicant states in the previous dependence of the claims from claim 1 was improper because claim 1 featured 500 bases while the length of claim 2 is 357 bases. Likewise, Applicant asserts that claims 3 and 5 cannot depend from claim 1 because the claims recite that the polynucleotides comprise 20 and 35 nucleotides, respectively. However, it is noted that the claims depending from claim 1, as presented in the 15 February 2005 claim set, recite that they comprise the entirety of SEQ ID NO: 2, comprise a polynucleotide which has at least 20 consecutive nucleotides of SEQ ID NO: 3 or comprise a polynucleotide which has 35 or more consecutive nucleotides of the sequence SEQ ID NO: 5. Given that the polynucleotide of claim 1 and the polynucleotides of each of claims 2, 3 and 5 are claimed using open language and the size limitations in claims 2, 3 and 5 are set forth as lower limits the polynucleotides of the dependent claims are within the scope of independent claim 1. For example, a polynucleotide comprising 500 or more consecutive nucleotides of SEQ ID NO: 1 can also comprise 20 consecutive nucleotides of SEQ ID NO: 3. Thus, the amendment is not necessary for the reasons stated by applicant and, because entry of the amendment would necessitate a new search and might raise new issues under 35 U.S.C. §112, first paragraph, the amendment will not be entered..

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are predicated on entry of the amendment and, as the amendment has not been entered, are moot. It is noted with respect to the rejection under 35 U.S.C. §112, first paragraph, that the identification of claim 16 as rejected is an obvious typographical error in view of the fact that the limitations discussed in the body of the claim are those of claim 15. Likewise, the limitations of claim 23 are mistakenly attributed to claim 24 in the body of the rejection. However, it is clear from the statement of the rejection as a whole that the rejected claims are 15, 23 and 24..